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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,399

Applicant(s)

MCGARIAN ET AL.

Examiner

Jennifer H Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 does not add any further structural limitations to the apparatus claim 16 thus is not considered to further limit the claim.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is considered indefinite because the "wherein" statement in the last portion of the claim is generally confusing. It is unclear to the examiner as to what specifically the applicant is referring and how the "slope" reduces an "increase in stress in said slope".

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braddick (US 5,595,247) in view of GB 2313391.

*Regarding claims 16 and 17:* Braddick discloses a whipstock casing milling system. The system includes the following features:

- A whipstock (160) with a whipface (254).
- A first ramp surface (259) and a second ramp surface (254) that meets the first ramp at a junction (see Figure 8). The first ramp is relatively steep compared to the second ramp surface relative to the longitudinal axis of the whipstock so that the first ramp is disposed at a greater angle to the longitudinal axis than the second ramp.
- A window mill (256) operable to form an opening in wellbore casing (C). The milling elements of the mill engage the first ramp and are deflected by that ramp laterally into the casing. (See Figure 9)
- A protrusion (260) located on the whipface. The protrusion is an extension of the first ramp and together they form a mill-deflecting slope. As recited in column 14, lines 54-56, the protrusion will be partially milled off during the milling operation thus the protrusion will reduce the damage to the first ramp at the junction of the first and second ramp. The protrusion would also move the milling elements past the first ramp thus reducing the stress on the first ramp and the whipstock.

Braddick discloses all of the limitations of the above claims except for the mill being secured to the whipstock. In Figure 4, GB 2313391 teaches a mill that is secured to a whipstock where the whipstock includes a first and second ramped surface. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have secured the mill of Braddick to the whipstock as taught by GB 2313391 in order to have reduced the cost of the operation by only having to make one run into the wellbore.

*Regarding claim 18:* The protrusion is located on the second ramp (see Figures 8 and 9).

*Regarding claims 19 and 20:* The means for securing taught by GB 2313391 is a shear bolt (see page 13, lines 15-27). The examiner notes that it is well known in the art that bolts are a threaded fastener.

*Regarding claim 21:* The protrusion includes a surface that is ramped at the same angle relative to the longitudinal axis of the whipstock as the first ramp (see Figures 8 and 9).

*Regarding claim 22:* As seen in Figure 4 of GB 2313391, the angle of the first ramp surface is 15° relative to the longitudinal axis of the whipstock.

6. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2313391 in view of Braddick (US 5,595,247).

*Regarding claims 16 and 17:* GB 2313391 discloses a whipstock casing milling system. The system includes the following features:

- A whipstock (44) with a whipface (46).
- A first ramp surface (see Figure 4) and a second ramp surface (46) that meets the first ramp at a junction. The first ramp is relatively steep compared to the second ramp surface relative to the longitudinal axis of the whipstock so that the first ramp is disposed at a greater angle to the longitudinal axis than the second ramp.
- A window mill (32) operable to form an opening in wellbore casing (9). The milling elements of the mill engage the first ramp and are deflected by that ramp laterally into the casing. (See Figure 4) The mill is attached to the whipstock by a securing means (39).

GB 2313391 discloses all of the limitations of the above claims except for a protrusion extending from the first ramp.

Braddick teaches a whipstock that includes a protrusion (260) located on the whipface (254). The protrusion is an extension of the first ramp and together they form a mill-deflecting slope. As recited in column 14, lines 54-56, the protrusion will be partially milled off during the milling operation thus the protrusion will reduce the damage to the first ramp at the junction of the first and second ramp. The protrusion would also move the milling elements past the first ramp thus reducing the stress on the first ramp and the whipstock.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the protrusion of Braddick on the whipstock of GB 2313391 in order to have protected the whipstock from being damaged (see col. 14, lines 40-58).

*Regarding claim 18:* As seen in Figures 8 and 9 of Braddick, the protrusion is located on the second ramp.

*Regarding claims 19 and 20:* The means for securing is a shear bolt (see page 13, lines 15-27). The examiner notes that it is well known in the art that bolts are a threaded fastener.

*Regarding claim 21:* As seen in Figures 8 and 9 of Braddick, the protrusion includes a surface that is ramped at the same angle relative to the longitudinal axis of the whipstock as the first ramp.

*Regarding claim 22:* As seen in Figure 4, the angle of the first ramp surface is 15° relative to the longitudinal axis of the whipstock.

### ***Response to Arguments***

7. In view of applicant's amendment, the objections to the drawings have been withdrawn.
8. The 35 U.S.C. 112.2 rejections of claims 1-15 are moot in view of claims 1-15 having been cancelled by applicant's amendment.
9. Applicant's arguments with respect to claims 16-22 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

JHG   
July 8, 2003

  
William Neuder  
Primary Examiner